



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Majid SYED	Confirmation No.:	3234
Serial No.:	10/007,338	Art Unit:	2448
Filed:	October 26, 2001	Examiner:	Philip C. Lee
For:	System and Method for Providing a Push Gateway Between Consumer Devices and Remote Content Provider Centers	Attorney Docket No.:	011969-0004-999 (formerly 708034-605001)

PRE-APPEAL-BRIEF REQUEST FOR REVIEW

Claims 1-14, 16-36, 39, 40, 65-79 and 81-93 stand finally rejected. Claims 1, 18, 21-23, 25, 66, 83, 86-87, 89-90 and 93 stand rejected under 35 U.S.C. § 102(e) as allegedly unpatentable over U.S. Patent Application Publication 2002/0095288 ("Corts"). Claims 13-14, 16, 78-79 and 81 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Corts. The remaining claims (2-4, 6-12, 17, 19, 24, 27-36, 40, 67-77, 82, 84, and 88) stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Corts in combination with various other references. Applicants submit that the rejections fail to establish *prima facie* cases of anticipation or obviousness and are based upon clear errors of fact and law.

Claim Rejections Under 35 U.S.C. § 102

• **Claim 1 and its dependent claims 18, 21-23, 25, 66, 83, 86-87, and 89-90**

Claim 1 is for a digital radio broadcast system for processing over the air transmissions of data content. The processing system includes an "addressing module for processing said instructions from the content provider for extracting addressing information that identifies one or more digital radio broadcast receivers for receiving said over the air transmissions of data content" (emphasis added). The Office relies on paragraphs [0283] and [0285] of Corts in alleging:

Corts teaches formatting and timing directives include codes to identify the datacast's consumer (0285). Corts further teach datacast elements are rendered by the user on IBOC receiving

device (0283). This means Corts teaches addressing information (directives) that identifies one or more digital radio broadcast receivers (consumer with IBOC receiver) for receiving said over the air transmission of data content (receiving datacast).

Final Office Action at p. 18, Par. 70 (emphasis added). Applicant respectfully disagrees with the Office's assessment

Claim 1 requires addressing information that identifies one or more digital radio broadcast receivers, whereas Corts, in contrast, discloses using information that identifies consumers (users) of the device. The Office has erred by equating a digital radio broadcast receiver to a user (consumer), but they are plainly two different things. Indeed, Corts explicitly discloses using codes to identify the consumer (user): "These directives include ... separation of different datacast elements, order of appearance, color, layout ... as well as codes to identify the datacast's consumer" Corts at Par. 0285. It is also erroneous for the Office to assume a correlation between the identity of a user and the identity of a particular receiver. Any number of users could use a particular receiver device at any given time, one user could have multiple receiver devices, and possession of a receiver device could be transferred from one user to another. The system of claim 1 is agnostic about who is using it and instead is limited to addressing information that identifies the receiver device itself. Because Corts does not disclose this limitation of claim 1, the rejection of claim 1 under 35 U.S.C. § 102(e) in view of Corts is improper and should be withdrawn. Dependent claims 18, 21-23, 25, 66, 83, 86-87, and 89-90 are allowable at least by virtue of their dependency.

- **Claim 93**

Independent claim 93 requires "an exciter for receiving the encoded data content from the gateway and for broadcasting the data content over the air via digital radio broadcast transmission." The Office relied on paragraph [197] of Corts as teaching "receiving data content at a broadcast facility and broadcasting the data content via IBOC." Final Office Action Par. 71. From this, the Office concludes that an exciter must inherently be included.

Id. “Inherency, however, may not be established by probabilities and possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). As noted at MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990).

Under the correct standard for inherency, there is no inherent disclosure in Corts of the claimed exciter. At most, Corts discloses that “data is transferred to a radio station or other broadcast facility where it is combined with the digital audio and inserted into the broadcast.” Corts [197]. But it does not suggest that such a function is necessarily performed by an “exciter for receiving the encoded data content from the gateway and for broadcasting the data content over the air via digital radio broadcast transmission” as required by claim 93. It is improper for the Office to assume that the claimed exciter necessarily is used. For at least the above-noted reason, and for other reasons already of record, withdrawal of the rejection and allowance of independent claim 93 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

- **Claims 13-14, 16, 78-79 and 81**

Claims 13-14, 16, 78-79 and 81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Corts. These claims depend from claim 1. It is respectfully submitted that the rejections of these claims is overcome by the arguments set forth above in connection with the independent claim 1.

- **Claims 5, 20, 26, 39, 65, 85, and 91-92**

Claims 5, 20, 26, 39, 65, 85, and 91-92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Corts in view of Garrity. Claims 5, 20, 85, and 91-92 depend from claim 1. It is respectfully submitted that the rejections of these claims is overcome by the arguments set forth above in connection with claim 1.

Regarding independent claims 26 and 39, each has a limitation similar to claim 1's addressing module. Claim 26 is for a method of processing over the air transmissions using a digital radio broadcast system, including "processing said instructions from the content provider...to determine addressing information that identifies one or more digital radio broadcast receivers...." Claim 39 is for an article of manufacture comprising a computer readable storage medium having computer readable program code embodied thereon, for processing over the air transmissions using a digital radio broadcast system, the code causing the system to "process said instructions from the content provider...to determine addressing information that identifies one or more digital radio broadcast receivers...." The Office has rejected claims 26 and 39 based on the same reasoning used for claim 1. *See* Final Office Action Par. 26. However, as argued above, Corts does not disclose the claimed limitations of addressing information that identifies one or more digital radio broadcast receivers. As such, the Office has failed to establish a *prima facie* case of obviousness of claims 26 or 39 and the rejection of these claims should be withdrawn. Dependent claims 27-36, 40, 65, 91 and 92 are allowable at least by virtue of their dependency.

- **Remaining Claims**

The remaining claims (2-4, 6-12, 17, 19, 24, 27-36, 40, 67-77, 82, 84, and 88) stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Corts in combination with various other references. Claims 2-4, 6-12, 17, 19, 24, 67-77, 82, 84 and 88 depend from claim 1 and are allowable at least by virtue of their dependency. Claims 27-36 depend from

claim 26 and are allowable at least by virtue of their dependency. Claim 40 depends from claim 39 and is allowable at least by virtue of its dependency.

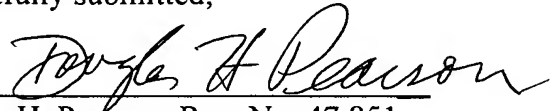
Conclusion

The rejections in the Final Office Action do not establish *prima facie* cases of anticipation or obviousness and are based upon clear errors of fact and law. For at least the reasons given above, it is respectfully requested that the rejections be withdrawn and that a Notice of Allowance be issued.

Respectfully submitted,

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